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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 787,613	03 20 2001	Heinz Isak	49458	4678

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KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

TUCKER, ZACHARY C

ART UNIT	PAPER NUMBER
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1624

DATE MAILED 02 14 2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/787,613

Applicant(s)

ISAK ET AL.

Examiner

Zachary C. Tucker

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**Status of**

**Claim Rejections - 35 USC § 103**

Upon consideration of applicant's arguments presented in the Brief on Appeal, the previous rejection under 35 U.S.C. 103(a), based on US 5,221,762 (Wingert et al), are dropped.

**Status of Application**

The finality of the previous Office action is withdrawn. The following new rejection, under 35 U.S.C. 102(b), *infra*, is entered in the record.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,420,851 (Bloom et al).

The melting point determination of the 2-phenoxyethylbenzoic acid produced in Example 1 of Bloom et al anticipates the process of claims 1-4.

2-phenoxyethylbenzoic acid is first washed with water, then a melting point is reported. Note the 4-degree Celsius range for the first melting point. A second melting point is determined for a more highly purified 2-phenoxyethylbenzoic acid after an additional step of recrystallizing the product from ethanol, which melting point is only a

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1-degree Celsius range, and is at a higher temperature than the melting point of the 2-phenoxyethylbenzoic acid before this recrystallization.

The chapter entitled "The Melting Point Experiment," dealing with the determination of melting points, from The Organic Chem Lab Survival Manual A Student's Guide to Techniques, 4<sup>th</sup> ed. James W. Zubrick pages 102-119, John Wiley & Sons (1997) is included herewith to substantiate the assertion that the first melting point determination in Example 1 of Bloom et al reads on the process of claims 1-4.

Page 102 of the Zubrick reference states that a melting point, first, is not really a "point," rather a melting point is a temperature range. A range greater than 2°C is indicative of an impure compound. Therefore, the first melting point of Example 1 of Bloom et al, as is stated in that example, is the melting point (range) of the impure compound. Since the first melting point is that of a 2-phenoxyethylbenzoic acid which was extracted with benzene then washed with water, the impure 2-phenoxyethylbenzoic acid contains residual water and benzene, even though drying step and a step of benzene evaporation are disclosed. The drying and evaporation steps disclosed by Bloom et al are not 100% effective, as is demonstrated by the 4°C melting point range obtained. The impurity causing this incongruity in the two different melting points cannot be the drying agent because sodium sulfate is not soluble in the recrystallization solvent (ethanol), therefore would not have been removed by recrystallization from ethanol. Both benzene and water are soluble in ethanol. Therefore, the impurity must be either water or benzene, or most likely, some mixture of the two, else sodium sulfate, if present in the 2-phenoxyethylbenzoic acid, would have

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been retained therein and a similar result for the melting point would have been obtained in the second determination.

Applicant has defined a "water- or solvent-wet" 2-phenoxyethylbenzoic acid as one that contains anywhere from 0.1-50% by weight water or solvent, and that the 2-phenoxyethylbenzoic acid must only be heated to 1°C above its melting point in the process. Both limitations are inherent in Example 1 of Bloom et al.

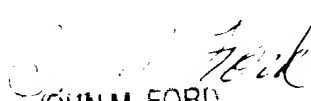
### **Conclusion**

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (703) 305-2050. The examiner can normally be reached Monday-Friday from 7:00am to 3:30pm. If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Ford, can be reached at (703) 308-4721. The fax number for the organization where this application or proceeding is assigned is (703) 308-4556 for regular communications and (703) 308-4242 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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JOHN M. FORD  
PRIMARY EXAMINER  
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